Remarks

Claims 2 and 4 are rejected as lacking novelty under 35USC§102(e) over 5 commonly owned patents. Claims 2 and 4 are also provisionally rejected under the doctrine of obviousness-type double patenting over Claims 1, 7 and 12 of U.S. Application No. 10/260,008 and over Claim 1 of commonly owned U.S. Application No. 11/587,448. These applications are now respectively U.S. patents 7,598,243 and 7,566,726. Claims 2 and 4 are also rejected under the doctrine of obviousness-type double patenting over Claims 1, 4-5 and 8-11 of U.S. patent 7,230,008, Claims 1-27 of U.S. patent 6,812,234; Claims 1-22 of U.S. Patent 7,393,844, Claims 1-24 of U.S. patent No, 7,166,614, and Claims 1-2 of U.S. patent No. 7,390,803. The last 5 patents named above are also commonly owned with respect to the instant application.

These rejections are traversed for the reasons summarized below.

35USC§102(e) Rejections

With respect to the rejections under 35USC§102(e), the Examiner argues that a patient taking a CCR2 antagonist for an inflammatory or immunoregulatory disorder would simultaneously also prevent neuropathic pain. The Examiner goes on to argue on page 3, that "one must necessarily administer before the presence of disease and therefore administration of the elected compound in any patient would then prevent pain."

This reasoning is not correct for several reasons. First, prevention of neuropathic pain is not claimed. The two pending claims both are directed to a method for treating neuropathic pain by administering a therapeutically effective amount of a compound to a patient in need of treatment. The patient population will be significantly different, because neuropathic pain is a chronic pain syndrome, which is described on page 1, lines 9-18 of the application. The patient population taking the drug comprises patients in need of treatment according to the claim language. A patient in need of treatment therefore will be a patient who already has neuropathic pain and is already feeling pain, unlike the patient population that the Examiner is referring to in her rejection.

The claim language does not mention "prevention", as suggested by the Examiner. The specification on page 3, lines 4-5, specifically states that CCR2 antagonists can be used to treat neuropathic pain. Furthermore, the specification on page 3, lines 7-8, states that "CCR2 antagonists can be used to treat, ameliorate, and/or prevent neuropathic pain." To treat and to prevent clearly have different meanings based on the language in this statement.

The patents cited by the Examiner are directed to the treatment or prevention of inflammatory and immunoregulatory disorders. There is no reason to expect these disorders to be accompanied by pain. Neuropathic pain is an abnormal sensory processing disorder that results in pain which does not necessarily have a visible cause and may not be accompanied by inflammation. There is no connection between neuropathic pain and the disorders in the cited patents that supports the rejection of claims directed to neuropathic pain as anticipated by the disorders in the cited applications.

Double Patenting

With respect to the double patenting rejections, the 7 patents that were cited, including the two that were pending applications when the Office Action was prepared, do not claim the treatment of neuropathic pain, or for that matter, any other kind of pain. The claims are generally directed to inflammatory diseases, immunoregulatory diseases, and rheumatoid arthritis, none of which are related to neuropathic pain. There are therefore no issues of double patenting.

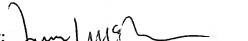
Conclusion

In view of the arguments and remarks above, the rejections should be withdrawn. Allowance of the claims is earnestly solicited.

If the Examiner wishes to discuss any matter regarding this Response, she is invited to telephone the undersigned attorney.

This Response is accompanied by a petition for a one-month Extension of Time and an authorization to charge the fee to Merck Deposit Account No.: 13-2755.

Respectfully submitted,

By: 

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Date: November 23, 2009